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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/821,170

04/09/2004

Akihiko Chiba

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4372 7590 03/19/2008  
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WASHINGTON, DC 20036

EXAMINER

ROE, JESSEE RANDALL

ART UNIT

PAPER NUMBER

1793

NOTIFICATION DATE

DELIVERY MODE

03/19/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

DCIPDocket@arentfox.com  
IPMatters@arentfox.com  
Patent\_Mail@arentfox.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/821,170	<b>Applicant(s)</b> CHIBA ET AL.	
	<b>Examiner</b> Jessee Roe	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 02 January 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 5-10 and 17-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 11-16 and 23-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of the Claims***

Claims 1-26 are pending wherein claims 1 and 15 are amended and claims 5-10 and 17-22 are withdrawn from consideration.

### ***Status of Previous Rejections***

The previous rejection of claims 1-4, 11-16 and 23-26 under 5 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in view of the Applicant's amendments to the claims.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-4, 11-16 and 23-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

With respect to the recitation "the alloy being Ni-free" of claims 1 and 15, the Examiner notes that although in paragraph [0006] of the "Related Art" section of the

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instant specification "there has been a strong demand for development of Ni-free fine wire with Mo content of 8 weight % or more", there is not a recitation of the alloy being "Ni-free" in the "SUMMARY OF THE INVENTION" section or the "EXAMPLES" section of the instant specification.

Claims 2-4, 11-14, 16 and 23-26 are rejected because of their dependence upon rejected base claims.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 11-16 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson (US 5,891,191).

Claims 1-4, 11-16 and 23-26 are rejected on the same grounds as set forth in the Office Action of 1 October 2007.

With respect to the amended feature of claims 1 and 15 which recites "for biomaterials", the alloy disclosed by Stinson ('191) would be biocompatible (col. 3, lines 32-45).

With respect to the amended feature of claims 1 and 15 which recites "the alloy being Ni-free", the alloy disclosed by Stinson ('191) would not necessitate the presence of nickel because the alloy disclosed by Stinson ('191) would contain "less than about 2

weight percent nickel”, which would include 0 weight percent (col. 3, lines 32-45 and claim 2). MPEP 2144.05 I.

Claims 1-4, 11-16 and 23-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stinson (US 5,891,191) in view of JP 2002-363675 A .

Claims 1-4, 11-16 and 23-26 are rejected on the same grounds as set forth in the Office Action of 1 October 2007.

With respect to the amended feature of claims 1 and 15 which recites “for biomaterials”, the alloy disclosed by Stinson ('191) would be biocompatible (col. 3, lines 32-45).

With respect to the amended feature of claims 1 and 15 which recites “the alloy being Ni-free”, the Examiner asserts that neither the alloy disclosed by Stinson ('191) nor JP '675 would not necessitate the presence of nickel because the alloy disclosed by Stinson ('191) would contain “less than about 2 weight percent nickel” (col. 3, lines 32-45 and claim 2), which would include 0 weight percent and JP '675 discloses the optional presence of carbon with 0 to 0.3 weight percent carbon (abstract). MPEP 2144.05 I.

### ***Response to Arguments***

Applicant's arguments filed 2 January 2008 have been fully considered but they are not persuasive.

The Applicant primarily argues that the composition of the instant invention would be different than that of Stinson ('191) because the instant invention does not contain nickel and because of the claim language "consisting of". In response, the Examiner notes that Stinson ('191) would not require nickel because "less than about 2 weight percent nickel" would include 0 weight percent and would therefore not patentably distinguish from Stinson ('191). Further, JP '675 would not necessitate added elements beyond that of chromium, molybdenum and cobalt because JP '675 discloses 0 to 0.3 weight percent carbon (abstract). Therefore, the compositions of the prior art would be substantially identical to the composition of the instant invention.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessee Roe whose telephone number is (571) 272-5938. The examiner can normally be reached on Monday-Friday 7:30 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Roy V. King can be reached on (571) 272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JR

/John P. Sheehan/  
Primary Examiner, Art Unit 1793

<b>Application Number</b> 	<b>Application/Control No.</b>	<b>Applicant(s)/Patent under Reexamination</b>	
	10/821,170	CHIBA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Jessee Roe	1793	